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OBLON SPIVAK MCCLELLAND
MAIER & NEUSTADT
1755 JEFFERSON DAVIS HIGHWAY
CRYSTAL SQUARE FIVE FOURTH FLOOR
ARLINGTON, VA 22202

In re Application of VANDERBIST et al.
Application No.: 09/424,247
PCT No.: PCT/BE98/00064
Int. Filing Date: 07 May 1998
Priority Date: 07 May 1997
Attorney Docket No.: 4068-0002-0 PCT
For: DRY POWDER INHALER EXCIPIENT,
PROCESS FOR ITS PREPARATION AND
PHARMACEUTICAL COMPOSITIONS
CONTAINING IT

DECISION ON PETITIONS
FOR REVIVAL UNDER 37
CFR §1.137(b) and TO
ACCEPT DECLARATION
UNDER 37 CFR §1.47(a)

This is a decision on applicants' "Petition to Revive An Unintentionally Abandoned Application Under 37 CFR §1.137(b)" and "Petition to Accept Declaration Under 37 CFR §1.47(a)" requesting the acceptance of the application without the signature of named inventor, Paul Maes. Both petitions were filed 30 November 1999 in the above-captioned application.

BACKGROUND

On 07 May 1998, applicants filed international application No. PCT/BE98/00064 which claimed a priority date of 07 May 1997, and which designated the United States.

No Demand was filed and as a result, the deadline for submission of a copy of the international application (unless previously communicated by the International Bureau) and payment of the basic national fee was to expire 20 months from the priority date, at midnight 07 January 1999.

On 30 November 1999, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, basic national filing fee, a

petition to revive an unintentionally abandoned application under 37 CFR §1.137(b) and a petition to accept Declaration under 37 CFR §1.47(a).

PETITION TO REVIVE UNDER 37 CFR §1.137(b)

A petition under 37 CFR §1.137(b) requesting that the application be revived on the grounds of unintentional delay must be accompanied by (1) a proper reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply to the filing of a grantable petition pursuant to this paragraph was unintentional", and (4) any terminal disclaimer and fee required pursuant to 37 CFR §1.137(c).

As to Item (1), the proper reply, the basic national fee of \$840.00, was submitted. With regard to Item (2), the appropriate petition fee of \$1,210.00 was provided.

With regard to item (3), applicants' statement that "the entire delay in filing this application in the U.S. Patent Office from the due date for entering the national stage until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals the requirements of 37 CFR §1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. §371(d) is granted as to the National stage in the United States of America.

PETITION UNDER 37 CFR §1.47(a)

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Per applicants' authorization the \$130 petition fee will be charged to applicants' deposit account no. 15-0030 to satisfy Item (1), the payment of the petition fee.

Regarding Item (3), the declaration proved gives last known address of the non-signing inventor, Paul Maes.

Regarding item (4) above, the declaration executed by Mr. Francis Vanderbist and Mr. Philippe Baudier is acceptable since it is clear that the co-inventors signed the declaration on behalf of the nonsigning inventor, Mr. Maes.

With regard to Item (2) above, Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR §1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

No affidavit or declaration has been provided with the petition under 37 CFR §1.47(a). What is required is the declaration of co-inventor Philippe Baudier, the person having firsthand knowledge of Paul Maes' refusal to sign, providing details of the *bona fide* attempt that was made to present a copy of the declaration to the non-signing inventor for his signature. The petition itself indicates that Mr. Baudier forwarded a letter to Mr. Maes, dated September 27, 1999 in an effort to obtain Mr. Maes signature on the declaration and assignment forms. However, a copy of said letter from Mr. Baudier to Mr. Maes is not attached and referenced.

A copy of the envelope allegedly sent to Mr. Maes from Mr. Baudier was attached to the petition. The envelope was marked "Return to Sender" and "Moved Refused 1 October 1999". There is no indication that these notations were made by Mr. Maes. It appears that the address label covers a portion of the "Return to Sender" label. No explanation is given for this.

Furthermore, the label is addressed to Paul Maes at an address in Ontario, Canada. This is not the address listed for Paul Maes in either the publication or the declaration and no explanation is provided. It is not clear from the petition or the envelope itself that Mr. Maes refused to sign the declaration. Also attached to the petition is what appears to be a mailing receipt to Paul Maes; however, the receipt carries no receipt number or date-stamp nor is there any explanation as to its significance. The circumstances of Mr. Maes refusal have not clearly been provided as required under 37 CFR §1.47(a).

Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.137(b) is GRANTED.

The petition under 37 CFR §1.47(a) is **DISMISSED** without prejudice.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Leonard E. Smith
Legal Examiner
PCT Legal Office

CMK/LES:cmk



Cynthia M. Kratz
Petitions Attorney
PCT Legal Office

Telephone 703-306-5467